

Response under 37 C.F.R. §1.114
Application No. 10/719,020
Attorney Docket No. 032130

REMARKS

Claims 20, 22-27 and 29-31 are pending in this application, of which claims 20, 26, 27, 30 and 31 have been amended. No new claims have been added. Claims 21 and 28 have been cancelled in this Response.

(1) Claims 26, 30 and 31 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Please see Section 3 of the outstanding Office Action.

Claims 26, 30 and 31 have been amended.

In claim 20, the thin resistance layer is plated or formed on the first surface of the conductive metal foil, and in claim 26, the insulating material is adhered (bonded) to the thin resistance layer formed on the first surface (page 10, lines 12-18). The conductive metal foil is subjected to an etching process from the second surface thereof, so as to make a circuit pattern. Claims 26 and 31 do not recite that "*the thin resistance layer is not necessarily between the conductive metal foil and the insulating layer,*" as stated by the Examiner. Claim 26 and 31 recite the insulating material such that the insulating material is adhered to the thin resistance layer. Reconsideration of the rejection is respectfully requested. If the rejection is maintained, Applicants request the Examiner to explain the reason of the rejection more in detail.

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(2) Claims 20, 22-25, 27 and 29 were rejected under 35 U.S.C. §102(b) as being anticipated by Kiyokawa (U.S. Patent No. 5,961,808).

Claims 20 and 27 have been amended to incorporate the limitations of claims 21 and 28, respectively. Thus, the rejection under 35 U.S.C. §102(b) on claims 20, 22-25, 27 and 29 should be made moot.

(3) Claims 20-31 were rejected under 35 U.S.C. §103(a) as being unpatentable over Rice et al. (U.S. Patent No. 4,888,574), and in view of Kazanovtse et al. (WPI World Patent Information Derwent, Vol. 29).

In response to the applicants' previous arguments based on the unexpected results, the Examiner states that Applicants have not demonstrated that superior appearance has been obtained over the entire breadth of the claimed invention.

However, a showing of unexpected results for a single member or a claimed subgenus, or a narrow portion of a claimed range would be sufficient to rebut a prima facie case of obviousness if a skilled artisan could ascertain a trend in the exemplified data that would allow him to reasonably extend the probative value thereof. In re Clemens, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA). MPEP 2144.08 II B.

In the present invention, one skilled in the art can ascertain that claims 20 and 27 recite a nickel sulfamate concentration of 300 to 600 g/l. Examples 1-5, prepared in the plating bath including nickel sulfamate at a concentration of 350g/l and 450g/l, shows much better appearance, compared with Comparative Examples 1, 3 and 4, prepared in the plating bath including nickel sulfamate at a concentration of 0g/l, 150g/l and 50g/l, respectively. Kazanovtse discloses nickel sulfamate of 120-140g/l. One skilled in the art can ascertain a trend of the results in Examples 1-5 and Comparative Examples 1, 3 and 4, that would allow him or her to reasonably extend the probative value thereof.

(4) Claims 27-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Atobe (JP59-50190).

The Examiner maintains the 103(a) rejection over Atobe because the disclosed parts *may be* described as “conductive metal foil...” Section 15 of the outstanding Office Action. The Examiner is requested to review what Atobe discloses. Atobe does not disclose or suggest any circuit board material.

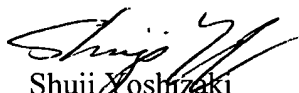
(5) In view of the aforementioned amendments and accompanying remarks, Applicants submit that that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date. If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned

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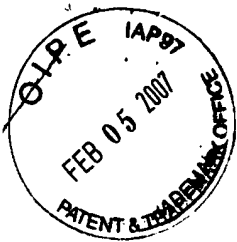
representative at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
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Expires: July 7, 2007



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